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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/686,563 | 10/11/2000 | Ying-Li Wu | QWEST# 1789 | 5238 |
| 22193 | 7590 | 04/28/2004 | EXAMINER | |
| QWEST COMMUNICATIONS INTERNATIONAL INC LAW DEPT INTELLECTUAL PROPERTY GROUP 1801 CALIFORNIA STREET, SUITE 3800 DENVER, CO 80202 | | | FERRIS, DERRICK W | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 2663 | 6 |

DATE MAILED: 04/28/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 09/686,563 | WU ET AL. | |
| | Examiner | Art Unit | |
| | Derrick W. Ferris | 2663 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 March 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1 and 11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1 and 11 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 22 March 2004 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____. |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Response to Amendment

1. **Claims 1 and 11** as amended are still in consideration for this application. Applicant has amended claims **1 and 11**. Applicant has canceled claims **2-10 and 12-25**.
2. Examiner **withdraws** the objections to the drawings for Office action filed 01/21/04. Examiner thanks applicant for making the necessary changes to the claims.
3. Examiner **withdraws** the claim objection(s) for Office action filed 01/21/04. Examiner thanks applicant for making the necessary changes to the claims.
4. Examiner **withdraws** the 112-second paragraph rejection(s) for Office action filed 01/21/04. Examiner thanks applicant for making the necessary corrections to clarify the recited claimed subject matter and thus withdraws the rejection.
5. Examiner **withdraws** the anticipated rejections to *Hamilton* and *Milbrandt* for Office action filed 01/21/04. See new obviousness rejection below with respect to applicant's arguments. In particular, applicant argues that *Milbrandt* does not teach the further limitation "use the dialog processing device to monitor the terminating connection during operation of the modem". Examiner respectfully disagrees. See e.g., column 10, lines 36-52.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 1 and 11** are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,633,545 B1 to *Milbrandt* in view of U.S. Patent No. 5,404,400 A to *Hamilton*.

In making a proper obviousness rejection under MPEP 706.02(j), the examiner will address the following four steps:

- a) *the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line numbers where appropriate;*
- b) *the difference of differences in the claim(s) over the applied cited references;*
- c) *the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter; and*
- d) *an explanation why one skilled in the art at the time of the invention was made would have been motivated to make the proposed modification.*

As such to **claims 1 and 11**, for step (a) *Milbrandt* discloses software for performing classification, see e.g., column 6, line 55. As such, see figure 4 with respect to a plurality of telephone numbers relating to terminal connections. With respect to classifying a connection see figure 8. With respect to the limitation “use the dialog processing device to monitor the terminating connection during operation of the modem”, see e.g., column 10, lines 36-52.

For step (b) *Milbrandt* may be silent or deficient to the further limitation classifying the terminating connection as a facsimile machine if the modem successfully establishes a connection to the terminating connection at a negotiated maximum baud rate less than 1000 bits/sec. However, the examiner notes that above limitation may be taught since *Milbrandt* teaches using any protocol which would include a fax protocol, see e.g., column 5, line 3. However, if this assumption above is incorrect, then the examiner notes the following obviousness rejection.

Hamilton teaches the further recited limitation above at e.g., the abstract.

For step (c), the proposed modification of the above-applied reference(s) necessary to arrive at the claimed subject matter would be to modify *Milbrandt* to clarify that any protocol could also include a fax protocol.

In order to establish a *prima facie* case of obviousness for step (d), three basic criteria must be met. The three criteria according to MPEP 706.02(j) are as follows:

First there must be some suggestion or modification, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

As such, for step (d) examiner notes that it would have been obvious to one skilled in the art prior to applicant's invention to include the further limitation classifying the terminating connection as a facsimile machine if the modem successfully establishes a connection to the terminating connection at a negotiated maximum baud rate less than 1000 bits/sec. In particular, the motivation for modifying the reference or to combine the reference teachings would be to communicate with a facsimile machine. In particular, *Hamilton* cures the above-cited deficiency by providing a motivation found at e.g., the abstract. Second, there would be a reasonable expectation of success since *Hamilton* further discloses classifying the type of the connection. Examiner would like to further point out that *Hamilton* teaches that it is well known in the art that a skilled artisan would recognize a fax protocol, see e.g., column 3, lines 48-50. Examiner agrees and notes that the specific threshold as defined by applicant of 1000 bits/sec is implicitly taught by V series specifications. In particular, examiner notes one skilled in the art would note that a facsimile communication typically starts out at a baud rate of 300 bits/sec (after a 2100

Hz tone) which is under 1000 bits/sec while an analog modem connection typically starts out at the highest bit rate supported such as 56.6 or 33.6 kbps which is above 1000 bits/sec. In particular, this assumption is supported via the V.21, channel 2 specification for a facsimile and the V.29 standard for a modem. These specifications are inherently taught as part of the V-series protocols supported by *Milbrandt*, see e.g., column 4, lines 59-67 and column 24, lines 34-54. Thus the references either in singular or in combination teach the above claim limitation.

Conclusion

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Derrick W. Ferris whose telephone number is (703) 305-4225. The examiner can normally be reached on M-F 9 A.M. - 4:30 P.M. E.S.T.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chau Nguyen can be reached on (703) 308-5340. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Derrick W. Ferris
Examiner
Art Unit 2663


DWF


CHI PHAM
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600 9/26/07